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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,361	08/31/2001	James Robert Kitchen	5681-03900	2095

7590

07/16/2003

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EXAMINER

PAIK, STEVE S

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/945,361

Applicant(s)

KITCHEN, JAMES

Examiner

Steven S. Paik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 May 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☒ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the United Kingdom on August 31, 2000 and January 17, 2001. It is noted, however, that applicant has not filed a certified copy of the 0021456.9 and 0101215.2 applications as required by 35 U.S.C. 119(b). The Declaration and Power of Attorney, signed on October 24, 2001, indicates that the priority is claimed but Certified copies are not attached. The Amendment filed on May 6, 2003 notes that the Applicant filed certified copies on October 25, 2001. The examiner respectfully requests the applicant resend the certified copies of the foreign priority documents since they are not in the file.

### ***Response to Amendment***

2. Receipt is acknowledged of the Amendment filed May 06, 2003. The applicant cancelled claims 1-7 and added claims 30-33.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims presented in the Amendment filed on May 6, 2003 appears to be incomplete. The lack of an art rejection with this Office action is not an indication of allowable subject matter (i.e., even though the claim 32 is rewritten or amended to overcome the rejection

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under 35 U.S.C. 112 as discussed above). The disclosure/claimed language is such that it is impractical to conduct a reasonable search of the prior art by the Examiner.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8-31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujita et al. (US 4,774,399) in view of Inazaki et al. (JP403083480A).

Re claims 8, 11, 13-18, and 21-24, Fujita et al. disclose a reading station (apparatus 12) for reading (col. 2, ll. 3-10) a portable storage device (IC card 10) operable to provide a predetermined processing to a system unit, the storage device (IC card 10) comprises a circuit (integrated circuit 15), a circuit interface (IC card contacts; col. 6, ll. 1-5) and an opening (notch 16) at an edge of the device, the reading station comprises a device (IC card 10) receiver (IC card insertion hole 18) configured to receive the device (IC card 10) and a device reader (circuit accommodated in housing 17; circuit board 26) operable to interface (via connector 28) with the circuit interface (14) when the device (IC card 10) is received by the device receiver (IC card insertion hole 18), the device receiver further being configured to enable a restraint (engagement portion 30) to engage the opening (notch 16 or hole 40) in the device to retain the device (IC card 10) at the reading station (col. 3, ll. 26-59; col. 5, ll. 56-64), the restraint being located at the exterior (the engagement portion is located at the exterior of the housing 17) of the reading station (12). Fujita et al. further disclose different shapes of the restraint performing the same

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function of engaging the portable storage device at a secured reading position. As disclosed by Fujita et al. the shapes and method of securing the portable storage device may be selected based on the how the storage device is inserted via an insertion hole.

Although it is well known that an IC card has many different industrial applications, Fujita et al. do not specifically disclose the predetermined function is a system configuration.

Inazaki et al. disclose an IC card storing system configuration information to help its user organize the layout of a system. As mentioned above, an IC card has many other applications besides the system configuration information such as credit card information, electronic purse information, personal identification, a patient information, and toll access information and the like.

In view of Inazaki et al., it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further incorporate an IC card that stores a system configuration information in addition to the IC card reading apparatus (12) and the IC card (10) of Fujita et al. due to the fact that any IC card with a predetermined processing information can be used in the reading/processing apparatus for the purposes of completing a predetermined function of an IC card. Furthermore, such modification of employing an IC card with a system configuration information to the teachings of Fujita et al. would have been an obvious matter of design variation, well within the ordinary skill in the art, and therefore an obvious expedient.

Re claims 9, 19 and 20, Fujita et al. in view of Inazaki et al. disclose the reading station as recited in rejected claims 8 and 18 stated above, wherein the device receiver (IC card insertion hole 18) comprises a formation defining a passage (col. 5, ll. 56-64) configured to receive the portable storage device (IC card 10; col. 3, ll. 26-36 and col. 5, ll. 56-64). The front side where

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an IC card (10) is inserted is interpreted as a wall having an insertion slot (with a protuberance (cover 22) having a longitudinal and a latitudinal cross-sectional area).

Re claims 10 and 12, Fujita et al. in view of Inazaki et al. disclose the reading station as recited in rejected claims 9 and 11 stated above, wherein the passage is slot-shaped (IC card insertion hole 18) so as to receive a portable storage device (IC card 10) in the form of a system configuration device (col. 3, ll. 26-59 and col. 5, ll. 56-64).

Method claims 25-29 are essentially the same in scope as apparatus claims 8-10 and are rejected similarly.

Re claims 30 and 31, Fujita et al. in view of Inazaki et al. disclose the reading station as recited in rejected claims 8 and 11 stated above, wherein the portable storage device including:

- a circuit (IC 15);
- a circuit interface (14 and col. 5, ll. 31-33); and
- an opening (notch 16) at an edge of the device.

Re claim 33, Fujita et al. in view of Inazaki et al. disclose the reading station as recited in rejected claim 24 stated above, wherein the portable storage device, the portable storage device (IC chip may have many different applications as stated above) being operable to provide system configuration information to the computer system and including:

- a circuit (IC 15);
- a circuit interface (14 and col. 5, ll. 31-33); and
- an opening (notch 16) at an edge of the device.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 8-33 have been considered but are moot in view of the new ground(s) of rejection.

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The applicant cancelled claim 1-7 and added new dependent claims 30-33. The applicant also amended independent claims to recite the restraint being located at the exterior of the reading station.

The examiner carefully considered the response and the newly added limitations in the independent claims. The present claims are rejected in view of the new ground of rejection. Therefore, claims 8-33 are rejected under 35 U.S.C. § 103(a).

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***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 703-308-6190. The examiner can normally be reached on Mon - Fri (7:00am-3:30pm).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

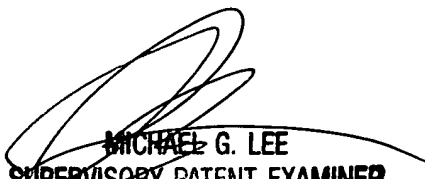
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0530.

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*Steven Paik*

Steven S. Paik  
Examiner  
Art Unit 2876

ssp  
July 1, 2003

  
MICHAEL G. LEE  
SUPERVISORY PATENT EXAMINER  
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